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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,674	02/05/2004	Tomoyuki Ohzeki	FS-F03227-01	3597
37398	7590	05/16/2006		EXAMINER
TAIYO CORPORATION				CHEA, THORL
401 HOLLAND LANE				
#407			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			1752	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/771,674	OHZEKI ET AL.	
	Examiner Thori Chea	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 February 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20040205</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. This first office action is responsive to the communication on February 5, 2004; claims 1-17 are pending in this instant application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamamoto et al (US 2003/0224307 A1). See the document as a whole, especially pages 96-99, claims 1-18 wherein the photothermographic material contains image forming layer containing at least a photosensitive silver halide, non-photosensitive organic silver salt, a reducing agent and a binder; the silver halide contains silver iodide from 40 to 100 mole %; the binder is polyvinylbutyral; spectral sensitizing of formula (3a)

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to (3d); and the compound of (Type 1) to (Type 5); page 57, [0519] wherein the non-photosensitive organic silver salt contains silver behenate from 30 mole % or more and 90 mole % or less; pages 59, [0536] wherein Tg binder is preferably from 40°C to 80°C; and the compound of pages 30-40 which contains a group adsorptive to silver halide and a reductive group. See also iridium compound and the amount thereof on page 4, [0049] and [0054]; the silver halide having particle size from 10 nm to 50 nm on page 3, [003]; the preparation of silver halide and the preparation of silver salt of an organic acid in presence of silver halide on page 81-82. The invention as claims contains the photosensitive silver salt and the binder has Tg overlaps those claimed in the presented invention. Therefore, the invention as claimed is either anticipated by or found prima facie obvious over the material taught in Yamamoto et al.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Okada et al (US Patent No. 6,120,983), Tzuzuki (US Patent No. 5,677,121), Siga et al (US Patent No. 4,332,889) and Tsukada et al (US 2002/0058220A1).

Okada et al discloses a photothermographic material substantially as claimed. See the compound having adsorptive to silver halide and reducible group in columns 12-20, compounds 1 to 55; photosensitive silver halide in column 36, lines 3-35 including silver iodide or silver iodobromide having silver iodide content of 0.1 to 40 mole %; silver salt of an organic acid including silver behenate in column 37, lines 20-41; preferred polymer such as polyvinyl butyral in column 41, lines 13-30; the silver halide doped with iridium complex in column 36, lines 18-35. Tzusuki (US Patent No. 5,677,121) discloses non-photosensitive silver salt comprising silver salt of behenic acid from 35 to 90 mole % to provide a heat developable material with excellent storability to ordinary aging, excellent image storability, high sensitivity and low

Dmax. See the disclosure in the abstract. Siga disclose in column 6, lines 43-68 disclose the relative amount of the silver iodide with respect to silver bromide to satisfy the sensitivity condition and storage condition. It is disclosed that "from the view point of sensitivity of image forming material, the silver halide is desired to contains, beside silver iodide, at least 2 mole %, based on silver halide component, silver bromide and/or silver chloride, although the silver halide may include only silver iodide, i.e. 100 mole % of silver iodide. Furthermore, from view point of stability of the raw image forming material, it is desired that silver halide component contains, besides silver iodide, silver bromide than silver chloride. Therefore, the most preferred silver halide component consists of silver iodide and silver bromide. In this case, silver iodide and silver bromide may be provided in either a mixture thereof or mixed crystals thereof. The molar ratio of silver iodide to silver bromide may be preferably 30/70 to 98/2, more preferably 50/50 to 95/5." Tsukada et al discloses a binder for a photothermographic material having glass transition temperature from -20 °C to 80 °C to provide a photothermographic material with good storability and good coating property.

Okada et al disclose a material substantially as claimed. The material taught therein includes the silver salt of an organic acid include silver behenate, silver iodide or silver bromoiodide having iodide content up to 40 mole %, preferred binder such as polyvinyl butyral and the compound having a group adsorptive to silver halide and a reducible group. Okada my not specifically discloses the Tg of the binder, but the polyvinyl butyral is the preferred binder and used in this present invention such as claimed in claim 8. The glass transition temperature of 45 deg. C is inherent to the polyvinyl butyral binder. Tsuzki discloses the optimized range of silver behenate in the silver salt of an organic acid within the claimed range to provide a

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photothermographic material with excellent storability to ordinary aging, excellent image storability, high sensitivity and low Dmax. Siga discloses the optimize range of silver iodide content in a heat developable material to balance the sensitivity and the stability of the raw image forming material. Moreover, Tsukada et al discloses a binder for a photothermographic material having glass transition temperature from -20 °C to 80 °C to provide a photothermographic material with good storability and good coating property. Therefore, it would have been obvious at the time the invention was made to optimize the amount of silver behenate such as taught in Tsuzuki in combination with the preferred binder included polyvinyl butyral taught in Okada or in Tsukada et al to form a material taught in Okada with an expectation of achieving a material with excellent storability to ordinary aging, excellent image storability, high sensitivity , low Dmax and good coating property, and thereby provide a material as claimed. The worker of ordinary skill in the art would have selected the silver halide iodide or silver bromide such as presented in claim 3-4 suggested in Okada et al due to the teaching of Siga et al.

6. Claims 9-11, 15-16 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Okada et al (US Patent No. 6,120,983).

See the compound having adsorptive to silver halide and reducible group in columns 12-20, compounds 1 to 55; photosensitive silver halide in column 36, lines 3-35 including silver iodide or silver iodobromide having silver iodide content of 0.1 to 40 mole %; silver salt of an organic acid including silver behenate in column 37, lines 20-41; preferred polymer such as polyvinyl butyral in column 41, lines 13-30; the silver halide doped a metal complex including with an amount of 1×10^{-9} to 1×10^{-2} mole/mole of silver including iridium complex in column 36, lines

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3-35. Okada discloses a photothermographic material containing compound having adsorptive to silver halide and reducible group, a photosensitive silver halide, an organic silver salt, a reducing agent , binder and the iridium. Therefore, the invention lacks novelty. Alternatively, it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to select the metal taught therein with an expectation of achieving a material with an increased sensitivity. The limitation in claims 15-16 are related to the claiming of a material by a process and fail to further limit the composition of the claimed material.

7. Claims 12 –14, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over as applied to claims 9-13, 15-18 above, and further in view of Kimura (US 6,413,711).

Okada et al fails to disclose the compound in claims 12-13 and the spectral sensitizing dye in claim 14, but these compounds has been known in Goto et al (US 2003/0194638), Ohezi (US 2002/0197570) and Kimura (US 6,413,711). See Goto pages 1-3; Ohzeki in the abstract and spectral sensitizing dye, compound (2a) to (2d) in the abstract. It would have been obvious to the worker of ordinary skill in the art to use the compound taught either in Goto or Ohzeki in the material of Okada et al to increase the sensitivity thereof and the use of the infrared spectral sensitizing dye taught in Kimura to spectrally sensitize the material of Okada in the infrared region, and thereby provide a material as claimed.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

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Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4-8, 12-15 of copending Application No. 10/412,214 in view of Tsuzuki (US Patent No. 5,677,121) and Tsukada et al (US 2002/0058220A1). The amount behenate in the silver salt of an organic acid and the binder having glass transition temperature may not be claimed in the copending application serial 10/412,214, but it has been known in Tsuzuki et al to provide a photothermographic material with excellent storability using a mixture of silver salts containing silver salt of behenic acid from not less than 35 to less than 90 mole % and binder having Tg -20 °C to 80 °C in Tsukada et al to provide a photothermographic material with good storability and good coating property. Therefore, it would have been obvious to the worker of ordinary skill in the art to use the silver salt of organic acid taught in Tsuzuki et al and the binder taught in Tsukada et al for same reason set forth therein, and thereby provide a material as claimed.

This is a provisional obviousness-type double patenting rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thorl Chea

Tch *TM*
2006-05-09

Thorl Chea
Primary Examiner
Art Unit 1752